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10/714,281	11/14/2003	James Castleman	109.0037	2030

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EXAMINER
LUBIN, VALERIE

ART UNIT	PAPER NUMBER
3626	

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03/17/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _22 December 2009_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _5-24_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _5-24_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Acknowledgements

1.   Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until

after the end of the THREE-MONTH shortened statutory period, then the shortened statutory

period will expire on the date the advisory action is mailed, and any extension fee pursuant to

37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of

this final action.

2.   Claims 5-24 are pending

For reference purposes, the document paper number is 20100309

Response to Arguments

3.   Applicant's arguments filed 12/22/2009 have been fully considered but they are not

persuasive.

4.   Applicant's traversal of the Official Notice(s) taken in the office action mailed 9/21/2009 is inadequate as it fails to "specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art." (MPEP 2144.03.C). However in order to advance prosecution, Examiner provides references. The first Official Notice for claim 9 is supported by Luchs et al., U.S. Patent No. 4,831,526 which discloses means for negotiating an insurance product (Fig 2 elements 82, 84; col. 16 lines 13-29). Examiner notes that the reference was cited in the last office action.   Regarding the Official Notice taken for claim 21, Tyler, U.S. Patent No. 5,523,942 discloses reducing policy costs based on certain parameters or clients' potential circumstances, such as early payments (Col. 33 lines 66-67, col. 7 line 1).

5.   As Applicant pointed out in his/her arguments, the second reference Debber was relied upon for a limitation not taught in Flagg, namely a risk data repository; and the third reference Libman, is relied upon for storing mortgage information (Fig. 9, col. 14 lines 23-27). The cited references when combined do read over Applicant's risk repository and evaluator. Where as Flagg describes the functions performed by such evaluator, i.e. "determining risks and costs associated with providing insurance and computing overall risk and cost for an insurance product and adjust parameters of the package components including adjusting the cost of an insurance product in light of the effect on said risk of the at least additional component to optimize the risk and cost of the insurance product" (Abstract, Fig. 2 element 90), Debber recites the structure of the system software itself (¶ 73) and Libman provides mortgage data (Fig. 9, col. 14 lines 23-27).

6.   Applicant argues that it would not have been obvious to one of ordinary skill in the art

to combine Flagg, Debber and Libman to provide as many types of insurance packages as

possible; however Examiner respectfully disagrees. Libman discloses combinations of

insurance products or in other words, packages. Given the list of products disclosed (Col. 14

lines 23-30), Examiner maintains that it would have been obvious to one of ordinary skill in

the art to combine the prior art in order to offer clients better, more customized products to

meet their needs at competitive prices. Furthermore, Examiner reiterates that the type of

insurance package (which is data) is non-functional descriptive material that does not further

limit the system of claim 5 (In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70

USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II).

7.   The rejection of claims 5-13 and 20-24 under 35 U.S.C. 101 is maintained; that of

claims 14-18 is removed in light of Applicant's amendments.

Claim Rejections - 35 USC § 101

8.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9.   Claims 5-13 and 20-24 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter.

10.   Independent claim 5 is directed to a system which comprises storage hosting a risk

data repository, and insurance data repository and a risk evaluator. The storage and

repositories constitute data and the risk evaluator is a software module. Hence, claim 5 is

directed to non-patent eligible statutory matter.

Claims 6-13 and 20-24, as dependents of claim 5, are also rejected under the above

analysis.

Claim Rejections - 35 USC § 103

11.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art
> are such that the subject matter as a whole would have been obvious at the time the invention was made to a
> person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be
> negatived by the manner in which the invention was made.

12.   Claims 5-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flagg

U.S. Patent No. 6,456,979 in view of Libman U.S. Patent No. 6,999,938, further in view of

Debber Pre-Grant Pub. No. 2003/0144887.

13.   For claim 5, Flagg discloses a system comprising: an insurance data repository

including information about available insurance components (Fig. 12 element 250); and

determining risks and costs associated with providing insurance and computing overall risk

and cost for an insurance product and adjust parameters of the package components

including adjusting the cost of an insurance product in light of the effect on said risk of the at

least additional component to optimize the risk and cost of the insurance product (Abstract,

Fig. 2 element 90).

Flagg recites a matrix of risk values (Abstract). He does not specifically recite a risk

data repository for storing risk information to be used in determining the risk and cost of

providing insurance packages and a risk evaluator; however Debber does (¶ 73). It would

have been obvious to one of ordinary skill in the art to combine the teachings of Flagg and

Debber to have a risk data repository and to perform Flagg's method using computer

software in order to readily access necessary risk data from such database and perform

calculations of different computing devices.

Flagg and Debber do not disclose the insurance data repository including information

about a mortgage insurance component and additional insurance components; however,

Libman does (Fig. 9, col. 14 lines 23-27). It would have been obvious to one of ordinary skill

in the art to combine the teachings of Flagg, Debber and Libman to include data about

mortgage insurance and insurance packages in order to market bundled products to

customers with more than one type of insurance need.

Claims 14 and 19 are rejected under the analysis of claim 5, as they recite the method

performed by the above system.

14.   For claim 6, Libman discloses a package terms development module and insurance

packages (Col. 20 lines 45-67; col. 21 lines 55-58; col. 14 lines 23-27). It would have been

obvious to one of ordinary skill in the art to combine the teachings of Debber and Libman to

allow for terms development based on different criteria in order to develop and market

packages that are suitable to potential customers.

Claims 15-17 and claim 24 are rejected under the analysis of claim 6.

15.   Claim 7 is rejected, as Debber recites an operator interface module (¶ 66).

Claim 8 is rejected under the analysis of claim 7.

16.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flagg U.S.

Patent No. 6,456,979 in view of Libman U.S. Patent No. 6,999,938, further in view of Debber

Pre-Grant Pub. No. 2003/0144887 and Luchs et al., U.S. Patent No. 4,831,526.

17.   For claim 9, Flagg, Debber and Libman do not recite a package negotiation module;

however, Luchs discloses means for negotiating an insurance product (Fig 2 elements 82,

84; col. 16 lines 13-29).   It would therefore have been obvious to one of ordinary skill in the

art to combine the prior art to include a means by which a consumer can negotiate a product

in order for providers to be more competitive.

18.   With respect to claim 10, Libman recites insurance packages (Col. 14. lines 23-27). A

predictable result of Flagg Debber and Libman would be to provide as many types of

insurance packages as possible to clients in order to offer them better more customized

products to meet their needs at competitive prices (KSR International Co. v. Teleflex Inc., 82

USPQ2d 1385 (U.S. 2007)). Furthermore, the type of insurance package is non-functional

descriptive material that does not further limit the system of claim 5 (In re Gulack, 217 USPQ

401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031

(Fed. Cir. 1994); MPEP 2106.01 II).

Claims 11 and 20 rejected under the analysis of claim 10.

19.   Claim 12 is rejected, as Debber recites a data processing system (Abstract).

20.   Claim 13 is rejected, as Debber recites the Internet (Abstract).

21.   For claim 18, Debber discloses presenting a hypertext form and receiving a

submission of information entered using the hypertext forms (¶ 92, 93, 96).

22.   Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Flagg U.S.

Patent No. 6,456,979 in view of Libman U.S. Patent No. 6,999,938, further in view of Debber

Pre-Grant Pub. No. 2003/0144887 and Tyler, U.S. Patent No. 5,523,942.

23.   With regards, to claim 21, Flagg, Debber and Libman do not specifically recite

discounting the computed cost by taking into account a reduced likelihood of default on the

mortgage due to the job loss component. However, Tyler discloses reducing policy costs

based on certain parameters or clients' potential circumstances, such as early payments

(Col. 33 lines 66-67, col. 7 line 1). It would therefore have been obvious to one of ordinary

skill in the art to combine the prior art in order to see the impact of such parameters on costs

and to accurately derive such costs.

Claim 22 is also rejected under the above analysis.

24.   With regards to claim 23, Debber discloses an experience modifier module 412 which

modifies insurance product data based on factors such as salary, job type, and historical loss

for example.   It would have been obvious to one of ordinary skill in the art to combine the

teachings of Flagg, Debber and Libman to include performance of a sensitivity analysis on

the different parameters involved in illustrating an insurance product or package, in order to

present different scenarios to customers that will help them choose the product that best

meets their financial situations.

Conclusion

25.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to VALERIE LUBIN whose telephone number is (571)270-5295.

The examiner can normally be reached on Monday-Friday 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jerry O'Connor can be reached on 571-272-6787. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

26.   Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published

applications may be obtained from either Private PAIR or Public PAIR. Status information for

unpublished applications is available through Private PAIR only. For more information about

the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to

the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197

(toll-free). If you would like assistance from a USPTO Customer Service Representative or

access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or

571-272-1000.

/V. L./
Examiner, Art Unit 3626

/C. Luke Gilligan/
Primary Examiner, Art Unit 3626